

Application No.: 09/895,768

Response to Final Office Action dated: November 21, 2006

Reply to Final Office Action dated: August 21, 2006

REMARKS/ARGUMENTS

Claims 1-15, and 19-29 are pending and rejected in the application. Claims 16-18 have been previously canceled.

Claim Objections

Claim 19 is objected to because of informalities. The appropriate corrections have been made in amended claim 19.

Claim Rejections Under 35 U.S.C. § 112

Claims 1-2, 3-11, 12-15, 19 and 21-29 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 1-2, 3-11, 12-15, 19 and 21-29 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have made appropriate amendments to the claims to overcome the rejections under 35 U.S.C. § 112, first and second paragraphs. Accordingly, applicants respectfully request that the rejections under 35 U.S.C. § 112 be withdrawn.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1, 4-7, 15 and 19-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Demos U.S. Patent No. 5,852,565 (hereinafter Demos-565) in view of Adobe-Dynamics-Media-Group, "A Digital Video Primer", pp. 1-31; June 2000 (hereinafter Adobe-Dynamics-Media-Group), and further in view of Demos U.S. Patent No. 6,442,203 (hereinafter Demos-203) and *Adobe After Effects Version 4.1 for Macintosh and Windows* (www.adobe.com) (hereinafter

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Adobe After Effects). Claims 2, 3, 8-14, and 27-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Demos-565 in view of Adobe-Dynamics-Media-Group, and further in view of Demos-203 and *Adobe After Effects*.

Page 2 of the Office Action dated August 21, 2006 states that Applicants' arguments filed on 6/27/06 are moot in view of new rejections. Similarly, page 2 of the Office Action dated April 4, 2006 states that Applicants' arguments filed on 7/22/2005 and 12/19/2005 are moot in view of new grounds of rejection. Applicants strongly disagree and assert that the arguments previously presented refute the Examiner's current rejections just as they did the previous rejections.

All four of the office communications received during the prosecution of this application have relied principally on the same flawed reference, Adobe-Dynamics-Media-Group, and the same flawed interpretation of 35 U.S.C. § 103(a). None of the Examiner's responses to Applicants' arguments have actually addressed Applicants' arguments. Instead, the Examiner has declared applicants' arguments moot in light of new rejections that, in reality, are nothing more than the Examiner's same old flawed arguments in a rehashed form.

Absent anticipation it may be possible to combine two or more patents together to render a claimed invention obvious, and unpatentable, under 35 U.S.C. § 103(a). In determining whether the claims are unpatentable it is necessary to look at what the references actually teach. "It is impermissible within the framework of § 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In Re Wesslau, 147 U.S.P.Q. (BNA) 391, 393 (C.C.P.A. 1965). Accordingly, a prior art reference

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must be considered in its entirety, and portions thereof must be taken in proper context. MPEP § 2141.02; Bausch & Lomb, Inc. v. Barnes-Hind, Inc., 230 U.S.P.Q. (BNA) 416, 419 (Fed. Cir. 1986).

35 U.S.C. § 103(a) states:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter **as a whole** would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

It is well established in the case law and apparent from a literal interpretation of 35 U.S.C. § 103(a) that an obviousness analysis must focus on the claimed invention as a whole, and not on the individual elements that comprise the invention. *See eg. Custom Accessories Inc. v. Jeffrey-Allan Industries, Inc.*, 1 U.S.P.Q.2d 1196 (Fed. Cir. 1986) ("Casting an invention as 'a combination of old elements' leads improperly to an analysis of the claimed invention by the parts, not by the whole.").

In the present office action as in the previous ones, the Examiner is picking and choosing unrelated parts of the prior art and trying to piece them together in an attempt to render the applicants' invention obvious. As shown above, the case law clearly and unequivocally states that this is not a proper application of 35 U.S.C. § 103(a).

On page 9 of the Office Action dated August 21, 2006, Examiner states "ON PAGE 5 of Applicant's specification, it is stated, 'the method is advantageous because it is straightforward to implement with commercial software currently available'"

[Emphasis in original] The fact that applicants' method can be implemented with

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commercially available software is completely irrelevant to the issue of patentability. Following this faulty reasoning, virtually any computer implemented method would be unpatentable, which is clearly not the case. Every computer-based method uses some sort of computer program or computer code to execute the method.

In light of the foregoing arguments, as well as the arguments previously presented, applicants assert that independent claims 1, 2, and 19 are allowable, and claims 3-15 and 21-29 are allowable as depending from allowable independent claims. It is respectfully requested that rejections under 35 U.S.C. § 103(a) be withdrawn.

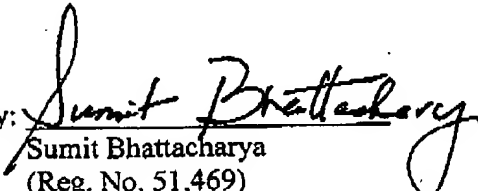
For all the above reasons, the applicants respectfully submit that this application is in condition for allowance. A Notice of Allowance is earnestly solicited.

The Examiner is invited to contact the undersigned at (408) 975-7500 to discuss any matter concerning this application.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 11-0600.

Respectfully submitted,

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